



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DR. DANIEL P. MORRIS, ESQ.
IBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPT.
P.O. BOX 218
YORKTOWN HEIGHTS NY 10598

COPY MAILED

MAR 06 2008

OFFICE OF PETITIONS

In re Application of :
Angelopoulos et al. :
Application No. 09/727615 : DECISION DISMISSING PETITION
Filed: 12/01/2000 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. YOR919960050US3 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on December 28, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional applications listed in the subject petition. This is also a decision on the concurrently-filed petition for expedited consideration of the petition under 37 CFR 1.78(a)(3).

The petition for expedited consideration is **GRANTED**.

The petition under 37 CFR 1.78(a)(3) is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i).¹ In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Before the petition can be granted, petitioner must submit a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3).²

Additionally, it is noted that the petition states that applicants seek to amend the claim of benefit to state, *inter alia*, that the subject application "is a CIP of pending US Application Serial No. 09/945,898, filed on 09-04-2001."

37 CFR 1.78(a)(3) states, in pertinent part:

If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a **prior-filed** copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed.

(emphasis added)

The above-referenced benefit claim is improper because the application to which benefit is claimed, Application No. 09/945,898, filed on September 4, 2001, was filed after the filing date of the subject application, No. 09/727,615, filed on December 1, 2000. An application may not claim the benefit of a later-filed application.

If applicant wishes to make a claim in Application No. 09/945,898, filed on September 4, 2001, for the benefit of the subject application, No. 09/727,615, filed on December 1, 2000, that claim of benefit to the subject application must be filed in the later-filed application.

Further, it is also noted that the benefit claim in the petition appears to state that Application No. 08/911,262, filed on August 14, 1997, is a continuation of application No. 09/727,615, filed on December 1, 2000. Again, this is not a proper benefit claim as the application to which benefit is

¹ It is noted that petitioner has submitted concurrently with the subject petition an amendment after final rejection containing changes to the claims, but the subject benefit claim is not in the amendment after final rejection. Rather, the benefit claim is contained within the petition itself.

² The claim for priority may also be made in an Application Data Sheet in compliance with 37 CFR 1.121 and 37 CFR 1.76(b)(5).

claimed is a later-filed application. Any renewed petition must be accompanied by a proper amendment containing a proper claim of benefit as specified in 37 CFR 1.78(a)(3).

The fees required for the petition to expedite and the petition under 37 CFR 1.78(a)(3) have been charged to counsel's deposit account, as authorized in the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Anthony Knight
Supervisor
Office of Petitions